Remarks

Claims 1 – 11 are pending.

Claims 1 – 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 9 of U.S. Patent No. 6,681,326.

Claims 1 – 3 and 11 are rejected under 35 U.S.C. §102(e) as being anticipated by Kupka et al., U.S. Patent 6434535 (Kupka).

Claims 4 – 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kupka in view of Heer et al., U.S. Patent No. 5,999,629 (hereinafter "Heer").

Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kupka in view of Garmeau et al. U.S. Patent No. 5,675,647 (hereinafter "Garmeau").

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Entry of this Amendment is proper under 37 CFR §1.116 because the amendment: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) satisfies a requirement of form asserted in the previous Office Action; (d) does not present any additional claims without canceling a corresponding number of finally rejected claims; or (e) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of the amendment is thus respectfully requested.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or simply is clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in

the most minimal way, i.e., simply to avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, because a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewritten to include the limitations of claims that previously depended from it. Thus, by such rewriting, no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

Double Patenting Rejection

Claims 1 – 9 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1 – 9 of Son et al., U.S. Patent No. 6,681,326.

Applicants appreciate the Examiners' comments but submit that at this point it is premature for Applicants to file a terminal disclaimer to overcome the non-statutory double patenting rejection because the patentable subject matter has not been yet determined. Applicants may have to amend the claims of the present application during its prosecution. Accordingly, such possible amendments may remove the basis for this rejection. Applicants respectfully request to hold the rejection in abeyance until the patentable subject matter is determined.

Rejection Under 35 U.S.C. §102

Claims 1 – 3 and 11 are rejected under 35 U.S.C. §102(e) as being anticipated by Kupka. The rejection is traversed.

Claim 1

In response to Applicants' arguments, the Examiner states that Applicants have argued that Kupka failed to disclose partially encrypted and fully encrypted video" (see Final Office Action, page 2). Applicants respectfully disagree. What Applicants have argued in the previous response is that Kupka failed to disclose the encryption process being spread between at least two different locations, i.e., the programming source and the distribution center, as claimed by Applicants. In particular, Applicants have argued that Kupka failed to disclose both the programming source and the distribution center storing a partially encrypted program and a process of transfer of such a program from the programming source to the distribution center (see Applicants' response filed on July 30, 2008, pages 6 – 8).

Accordingly, the Examiner has misconstrued Applicants' arguments and has failed to address the substance of Applicants' arguments traversing the §102 rejection. "Where the applicant traverses any rejection, the examiner <u>should, if he or she repeats the rejection</u>, take note of the applicant's argument and <u>answer the substance of it</u>" MPEP §707.07 (f). Therefore, Applicants respectfully request the Examiner to withdraw the finality of the present rejection.

The Examiner also states that

> "Kupka disclose if the digital content to be download is stored on the server 16 in an encrypted format, pre-encrypted, prior to downloading then the server would need only encrypt the data key to the content. Such a technique would greatly increase the security of the data to be transmitted, as the data may be double encrypted prior to transmission to the client. That means Kupka provides a second encryption before downloading the content to the user whether the content is stored one the server in an encrypted format, pre-encrypted format. <u>The main purpose of the invention is to provide pre-encryption and final encryption to the make the system safer against unauthorized users</u>"

(see Final Office Action, page 2) (emphasis added).

Applicants are not clear as to whose invention the Examiner refers in the highlighted portion and appreciate if the Examiner clarifies this point. However, notwithstanding whether the invention is Applicants' invention or Kupka's invention, Applicants note that determining a main purpose of an invention disclosed in a cited reference or in Applicants' specification is not a test used under 35 U.S.C. §102 to

determine whether the reference anticipates Applicants' claims. Rather, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, Kupka does not disclose "each and every element as set forth in the claim." For example, Kupka does not disclose "at least one programming source for storing at least one partially encrypted video program," as recited in independent claim 1. The Examiner argues that Kupka discloses this element in Figure 1. However, the Examiner fails to identify which particular item of Figure 1 the Examiner equates to Applicants' at least one programming source (see Final Office Action, page 4).

Applicants' claim 1 recites:

> "An interactive information distribution system, comprising:
>
> at least one programming source for storing at least one partially encrypted video program;
>
> a distribution center comprising a remote server, said remote server storing said at least one partially encrypted video program **received from said** at least one **programming source**, and said remote server processing said partially encrypted video program corresponding to a subscriber requested video program to produce a fully encrypted video program; and
>
> a subscriber-side distribution network coupled to the distribution center, for causing transmission of the fully encrypted video program to the requesting subscriber" (emphasis added).

Accordingly, as claimed, a partially encrypted video program is

(1) stored at a programming source; then

(2) received by a remote server of a distribution center from the programming source; then

(3) stored at the remote server of the distribution center; then

(4) processed at the remote center into a fully encrypted program; and then finally;

(5) the fully encrypted video program is provided to a requesting subscriber.

Generally, these steps may be visualized as shown in the following diagram:

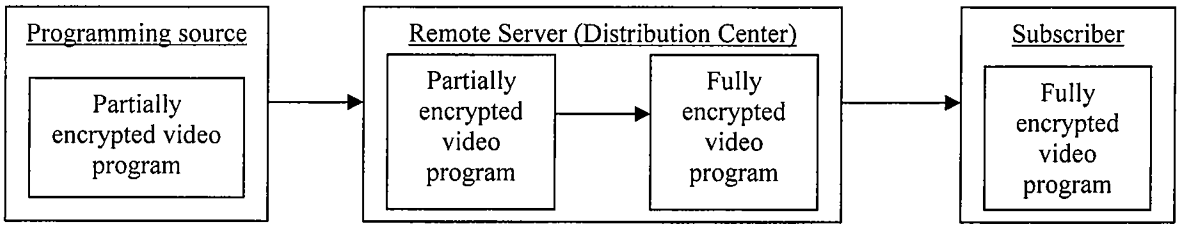

Diagram 1(Applicants' Claim 1)

Accordingly, the video program encryption process is spread between at least two different locations, the programming source and the distribution center, and the partially encrypted program is transmitted from the programming source to the distribution center.

This is entirely different from the Kupka's arrangement where electronic data (content) is transferred from a server to a client device via network infrastructure (*see e.g.*, col. 3, lines 31 – 35) and the encryption process is executed at a single server (see also col. 18, line 64 – col. 19 – line 27). The encryption process of Kupka may be visualized as shown in the following diagram:

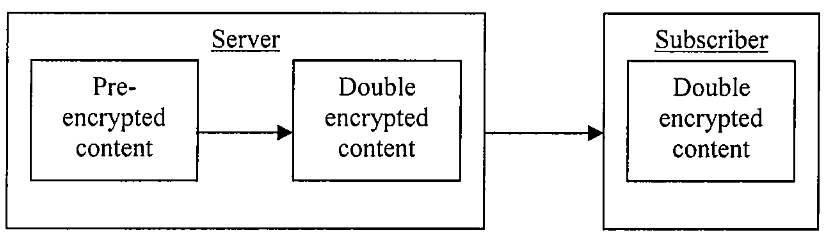

Diagram 2(Kupka's Arrangement)

Accordingly, even assuming *arguendo* that the pre-encrypted content of Kupka may be equated to Applicants' partially encrypted video program and that the double encrypted content of Kupka may be equated to Applicants' fully encrypted video program, whether the Kupka's server is equated to the Applicants' programming source or the remote server of the distribution center, the Kupka's arrangement lacks at least one of the two elements of the Applicants' claimed invention, either the programming source or the distribution center. Nowhere does Kupka disclose transferring pre-encrypted content from one server 16 to another server 16 for processing the pre-encrypted content into the double encrypted content. In particular, Kupka fails to teach or suggest that that

an entity encrypting the pre-encrypted content has received the pre-encrypted content from another entity that has been storing such pre-encrypted content.

Rather, Kupka merely suggests that "it may be preferable to double encrypt the downloaded content at step 308 by encrypting the pre-encrypted content and the data key to the pre-encrypted content..." (*see* Kupka, col. 19, lines 11 – 14), where step 308 is a step of method 300 shown in Fig. 7. Applicants note that because step 308 does not relate to content transmission process and occurs before any content transmission, the reference to step 308 is a typographical error and Kupka has intended to refer instead to step 318, where "server Encrypts Data and Transmits Encrypted Data Stream." Therefore, in the above quoted portion, i.e., col. 19, lines 11 – 14, Kupka suggests that at step 318, the server may encrypt the pre-encrypted content stored at the same server, and not stored at another entity. The server is the sole content source employed by the method 300.

Applicants also note that the Kupka's server cannot be interpreted as the Applicants' programming source because, after the server encrypts the stored content, no further encryption is performed. In contrast, according to Applicants' claim 1, after the partially encrypted video program is transmitted from the programming source, such a partially encrypted program is further encrypted at the remote server of the distribution center. Therefore, Kupka does not teach or suggest each and every element of the Applicants' invention as arranged in independent claim 1. Accordingly, Applicants' independent claim 1 is not anticipated by Kupka, and thus, is allowable under 35 U.S.C. §102.

Therefore, the §102 rejection of claim 1 should be withdrawn.

Claims 2 – 3 and 11

Claims 2 – 3 and 11 depend directly or indirectly from independent claim 1, while reciting additional limitations. Therefore, these dependent claims are also not anticipated by Kupka and are allowable under 35 U.S.C. §102 for at least the same reasons as discussed above with respect to independent claim 1.

Claim 2

Furthermore, with respect to claim 2, Kupka does not teach or suggest at least:

> "wherein said remote server causes transmission of a decryption key to said requesting subscriber via said subscriber-side distribution network, said decryption key being necessary to decrypt said fully encrypted video program,"

as recited in claim 2 (emphasis added). The Examiner suggests that this limitation is taught by Kupka because Kupka disclose that the data is stored on the media 28 in an encrypted format using at least a unique serial number as a decryption key (see Final Office Action, page 5). Applicants respectfully disagree.

First Applicants note that the Examiner has not cited any particular portion of Kupka to support such an argument with respect to claim 2. Second, while the "electronic content is written to the ... piece of media in encrypted format using the unique identifier" (see e.g., Kupka, col. 4, lines 35 – 38, col. 18, lines 46 – 48), Kupka fails to disclose "transmission of a decryption key to said requesting subscriber." In contrast, according to Kupka, such a unique identifier is transmitted from the media to the vendor server (see e.g., col. 3, lines 40 – 43). This unique identifier is embedded into the media and cannot be altered or copied (see col. 7, lines 53 – 55). Therefore, not only Kupka fails to disclose transmitting of the unique identifier to the requesting subscriber, but such a transmission is not needed as the subscriber is already aware of the unique identifier's value. Therefore, Kupka fails to teach or suggest each and every element of claim 2 as arranged in the claim, and thus, does not anticipate Applicants' claim 2.

Claim 3

Furthermore, with respect to claim 3, Kupka does not teach or suggest at least:

> "wherein said fully encrypted video program is encrypted according to a public key associated with said requesting subscriber, said **public key** having associated with it a **private key** necessary to decrypt said fully encrypted video program,"

as recited in claim 3 (emphasis added). The Examiner suggests that this limitation is taught by Kupka where the public key is the unique identifier described in col. 4, lines 34

– 35 and the private key is the unique serial number described in col. 18, lines 46 – 48 (see Final Office Action, page 5). Applicants respectfully disagree.

In particular, according to Kupka, the unique identifier and the unique serial number are different references to the same identifier (see e.g., col. 10, lines 55 – 59). Such an identifier is used as an encryption key to encrypt content and as a decryption key to decrypt the content. Therefore, at most, it may anticipate only one of the public and private keys of Applicants' claim 3. However, Kupka's identifier certainly cannot be considered to be a private key if it is a public key or to be a public key if it is a private key. Therefore, Kupka fails to teach or suggest each and every element of claim 3 as arranged in the claim, and thus, does not anticipate Applicants' claim 3.

Accordingly, the §102 rejection of claims 2 – 3 and 11 should be withdrawn.

Rejection Under 35 U.S.C. §103

Claims 4 – 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kupka in view of Heer. Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kupka in view of Garmeau. The rejections are traversed.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP §2141. Establishing a *prima facie* case of obviousness begins with resolving factual inquiries of Graham v. John Deere Co. 383 U.S. 1 (1966). The factual inquiries are as follows:

(A) determining the scope and content of the prior art;

(B) ascertaining the differences between the claimed invention and the prior art;

(C) resolving the level of ordinary skill in the art; and

(D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int'l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); see also MPEP §2141. According to MPEP §2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art" (*quoting*, *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). In addition, to establish a prima facie case of obviousness the prior art reference (or references when combined) must teach or suggest all elements of the subject claim. *In re Wada*, 2007-3733 (BPAI Jan. 14, 2008) (*citing*, *CMFT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed.Cir. 2003)).

Each of these grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §102 given Kupka. Because the rejection under 35 U.S.C. §102 given Kupka has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that the additional references supply that which is missing from Kupka to render the independent claims anticipated, these grounds of rejection cannot be maintained.

As such, claims 4 – 9 are not anticipated by Kupka in view of Heer and allowable under 35 U.S.C. §103(a) and claim 10 is not anticipated by Kupka in view of Garmeau and allowable under 35 U.S.C. §103(a).

<u>Claim 6</u>

Furthermore, with respect to claim 6, the Examiner acknowledges that Kupka fails to teach the limitations of claim 6. However, the Examiner suggests that Heer provides that what is missing from Kupka. In particular, the Examiner cites col. 1, line 52 and col. 2, line 63 as teaching Applicants' limitation of "wherein said <u>public key is encrypted prior to transmission</u> to said requesting subscriber" (see Final Office Action, page 7). Applicants respectfully disagree.

Col. 1, line 52 merely mentions an associated public key. Col. 2, line 63 states that a digital version of the video program has been compressed, encrypted, and stored in the server in association with the unique serial number and program identifier. However, the cited portions are silent with respect to whether the associated public key is encrypted, transmitted, transmitted to the subscriber, or encrypted prior to being

transmitted. Accordingly, because the cited references fail to teach the public key being encrypted prior to its transmission to the requesting subscriber, the *prima facie* case of obviousness with respect to claim 6 has not been established properly. *In re Wada*, 2007-3733 (BPAI Jan. 14, 2008) (*citing*, *CMFT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed.Cir. 2003)).

Accordingly, the rejection should be withdrawn.

Conclusion

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at 732-842-8110 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

Dated: 1/5/09

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